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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,389	01/22/2004	Michael T. Rossi	A8708	2413
23373	7590	05/19/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			KANG, JULIANA K	
			ART UNIT	PAPER NUMBER
			2874	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/761,389

Applicant(s)

ROSSI, MICHAEL T. 

Examiner

Juliana K. Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Applicant's communication filed on March 21, 2005 has been carefully studied by the Examiner. The arguments advanced therein, considered together with the amendments made to the claim 26 is not persuasive. In view of further search, however, and the consequent discovery of a previously uncited prior art document, a new rejection is applied to the some pending claims. Also rejections made under 103(a) applying the Shen and Thompson references are hereby withdrawn. This action is not made final.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 26 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Shen (U.S. Patent 6,321,012 B1).

Shen discloses a buffer tube (16) comprising of: a plurality of individual optical fibers (26) located within the buffer tube and arranged in a plurality of fiber optic bundles (12); and a detectable binder (14) having an adjustable laylength wherein the detectable

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binder surrounds the fiber optic bundle. Shen et al's binder is colored coded binder thus it is detectable (see column 3 lines 56-63). Also anything having a length can be adjustable thus Shen et al's binder is inherently adjustable and even though Shen does not use the term "flexible" since the binder is wound around the fiber bundle it has to be flexible.

4. Claims 26 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Oberschlake (AU 9211367A).

Oberschlake disclose an optical fiber cable wherein a binder comprising a ferrite powder that can be placed around buffer tubes. The limitation "detectable" is a recitation of the intended use and the limitation "an automated detection system" is not a positively recited limitation because it follows the intended use recitation. Since Oberschlake teaches that the binders having ferrite powder and is capable of detecting, Oberschlake teaches all the positively recited limitations.

5. Claims 32 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishikawa et al (U.S. Patent 6,243,519 B1).

Ishikawa et al disclose the claimed invention including an indicative tape (color, metal, or the like indicative) on a binder tape to detect the tape by a sensor (see column 1 line 65 to column2 line 12). Also anything having a length can be adjustable thus Ishikawa et al's binder is inherently adjustable.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa et al (U.S. Patent 6,243,519 B1) and further in view of Parris (US 2002/0009272 A1).

As described above Ishikawa et al teach the claimed limitations except fluorescing element. Parris teach using fluorescent colorants for coloring pigment in an optical cable element. Since Ishikawa et al teach using any suitable indicative on the binder, it would have been obvious to use fluorescent colorants in Ishikawa et al as taught by Parris for detection purpose.

8. Claim 27 is rejected under 35 U.S.C. 35 U.S.C. 103(a) as being unpatentable over Shen (U.S. Patent 6,321,012 B1) and further in view of Parris (US 2002/0009272 A1).

As described above Shen teach the claimed limitations except a fluorescing element. Parris teach using fluorescent colorants for coloring pigment in an optical cable element. Thus using fluorescent colorants of Parris in Shen would have been

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obvious to one having ordinary skill in the art at the time the invention was made to easily distinguish the colors.

9. Claims 27, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberschlake (AU 9211367A) and further in view of Lovie (U.S. Patent 5,809194).

As described above Oberschlake teach the claimed limitations including magnetic binder except a fluorescing element, a distinguishing color or an identifiable marking binder. Lovie teach using various detectable markings such as a metallic, magnetic, fluorescent or luminescent paint in an optical fiber cable. Therefore, because the above detectable markings were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute magnetic binder of Oberschlake with other markings as taught by Lovie.

### ***Response to Arguments***

10. In response to applicant's argument that the Shen reference does not teach that the markings used for the binders are detectable by an automated detection device. The Examiner does not agree with this. First the limitation "detectable" is a recitation of the intended use and the limitation "an automated detection system" is not a positively recited limitation because it follows the intended use recitation. Since Shen teaches that the binders have different colors and is capable of detecting, Shen teaches all the positively recited limitations. Please note that recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention


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and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliana K. Kang whose telephone number is (571) 272-2348. The examiner can normally be reached on Mon. & Thur. 10:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rod Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JULIANA KANG  
PRIMARY EXAMINER

5/17/05